

REMARKS

The examiner is thanked for the very thorough and professional office action. Pursuant to that office action, Claims 3-6 have been cancelled and Claims 1 and 2 rewritten to more definitely set forth the invention and obviate the rejections. The present amendment is deemed not to introduce new matter. Claims 1 and 2 remain in the application.

With regards to submission of the references listed in the instant specification, an Information Disclosure Statement was filed herein, along with each of said references, on May 24, 2011. Consideration of said references is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1-6 under 35 U.S.C. 112, second paragraph, as being indefinite.

Claims 1 and 2 have been rewritten to delete reference to Formula 1 and eliminate any confusion concerning the method of the present invention. It is therefore believed that the rejection is moot and withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claim 1 under 35 U.S.C. 103(a) as being unpatentable over Bowers in view of Matsuda, et al.

This rejection raises a number of issues, each of which is discussed separately below as follows.

1. Whether the examiner erred in determining the scope and content of the prior art as required by *Graham v. John Deere Co*, 383 U.S. 1 (1966), and

2. Whether the examiner erred in considering objective evidence present in the application indicating obviousness or non-obviousness as required by *Graham v. John Deere Co*,

supra.

Applicants respectfully submit that the answer to each of these issues is in the affirmative for the reasons discussed hereinafter.

The First Issue

Applicants respectfully submit that the prior art relied upon by the examiner was not considered in its entirety, including disclosures that teach away from the present invention.

The Law

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore Co. v. Gorlock and Associates, Inc.*, 271 F.2d 1540, (1983), cert.denied, 469 U.S. 851 (1984).

The Facts

The Bowers, et al. patent, the examiner's primary or principal reference, disclose a treatment process which is preferably conducted in an aqueous medium using a sodium bicarbonate buffer. Further, as described in the instant specification in paragraph [0004] on page 2, Bowers, et al. describes a phosphorylcholine carboxyl derivative that has been turned into an active ester, but it is believed that no synthesis method is taught, and thus the composition is not reproducible. Thus, Bowers, et al. does not teach that the method claimed herein is to be carried out in an organic solvent by means of an after-treatment.

Matsuda, et al., the examiner's secondary reference, relates to contact lenses in which ester bonding occurs in either an organic solvent or in an aqueous solvent. However, Matsuda, et al. are in no way concerned with treatment of the contact lens material with a phosphorylcholine group-containing chemical compound of Formula 2.

It is respectfully submitted that the examiner's primary reference of Bowers actually teaches a way from the process now called for in Claim 1 herein. Surely one of ordinary skill in the art would be led by the teachings of Bowers to use an aqueous solution, and not an organic solvent in an after-treatment. In contrast, Matsuda, et al. although treating a contact lens material does not disclose reacting the surface of the contact lens material in an after-treatment with a phosphorylcholine group-containing chemical compound as now required by Claim 1. For these reasons, it is respectfully submitted that there is no logical rationale for combining these references in the manner suggested by the examiner. Further, it is respectfully submitted that the combination rejection is based solely on hindsight, without any consideration of the fact that Bowers prefers to use an aqueous solution.

The Second Issue

Applicants contend that in the rejection the examiner failed to consider objective evidence of secondary considerations such as unexpected results.

The Law

Objective evidence of secondary considerations, such as unexpected results, are relevant to the issue of obviousness and must be considered in every case in which they are present. See MPEP 2141. It is the duty of the examiner to evaluate such evidence. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 513 (Fed.Cir. 1983).

The Facts

Applicants devote considerable discussions to examples and comparative examples. Fig. 1 in the specification shows the results of protein adsorption for Examples 1 and 2 and

comparative examples 1-7. These results indicate that the contact lenses of the present invention unexpectedly and significantly suppress protein adsorption. Failure to consider and discuss these tests in the rejection is believed to be required under the *Graham v. John Deere Co.* analysis for determining obviousness. Failing such consideration by the examiner is believed to constitute a fatal flaw in the examiner's analysis.

In view of the amendments herein, as well as the legal authorities cited above, it is respectfully submitted that the examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claim 2 under 35 U.S.C. 103(a) as being unpatentable over Bowers in view of Matsuda, et al., and further in view of Valint, Jr., et al.

The deficiencies of Bowers and Matsuda, et al. are discussed above.

In the rejection, the examiner recognizes that although Bowers teaches that synthetic polymers do not have adequate free surface hydroxyl groups, Bowers does not teach a specific method for achieving hydroxylation of a polymer surface. This preparation of the surface is, of course, an important feature or aspect of the invention.

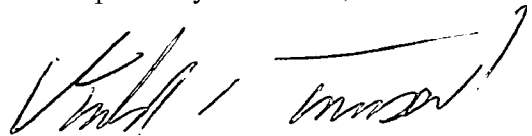
To cure the deficiencies of the examiner's primary and secondary references, the examiner then relies upon Valint, Jr., et al. which is concerned with surface treatment of a silicone hydrogel contact lens.

However, Valint, Jr., et al. in no way disclose an after-treatment of a contact lens material with the phosphorylcholine group-containing chemical compound as required by Claim 2 herein. Moreover, there is no suggestion in Valint, Jr., et al. that the plasma oxidation reaction disclosed

therein would be suitable for all types of after-treatments, much less the after treatment called for in Claim 2 herein. For these reasons, it is respectfully urged that there is no justification for combining the references in the manner suggested by the examiner except by hindsight. Consequently, the examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action and allowance thereof is accordingly respectfully requested. In the event there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Donald E. Townsend', written in a cursive style.

Donald E. Townsend
Reg. No. 22,069

Date: June 3, 2011

CUSTOMER NO. 27955

TOWNSEND & BANTA
Suite 900, South Building
601 Pennsylvania Ave., N.W.
Washington, D.C. 20004
(202) 220-3124